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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,757	06/25/2001	John E. Ahern	B0410/7282D1	2885

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EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,757

Applicant(s)

AHERN ET AL.

Examiner

Catherine S. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-32 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/05; 2/19/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The examiner reviewed the parent application and its contents for the references on 1449 dated 4/7/05. Only three foreign references were found in the parent application. Those references have been reviewed and initialed on the 1449 dated 4/7/05, copy enclosed. However, the remainder of the foreign references on the 1449 dated 4/7/05 are not contained the parent application file and have not been reviewed. It is requested that applicant forward copies of these references from their files for review upon the next action.

Claim Objections

Claims 31-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 31 recites the limitation of "means for receiving" which seems be a second positive recitation of the delivery chamber of claim 20, albeit different wording. Claim 32 positively recites "a port" which is assumed to be the same port as positively recited in claim 20. The examiner is assuming applicant is not invoking 112 6th paragraph and means plus function interpretation for the claim limitation since applicant has not stated such and since claim 31 recites sufficient structure including "an arcuate shape".

However, the instant specification including the drawings does not explicitly set forth the means for receiving. In applicant's response dated 3/23/05, applicant pointed to page 8 line 3 to page 10 line 13 for identification of the structures of the "means for receiving". These pages of

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the instant specification give a broad outline of the entire instant device and do not distinctly identify the “means”, i.e. structures. Additionally, applicant added new claim 32 to further identify that the “means for receiving” includes “a port formed from...fingers”.

In assessing applicant’s arguments, the drawings and new claim 31, one can only conclude that applicant intends the “means for receiving” to include the structure of the delivery chamber, the port and the fingers. Having identified these structures as constituting the “means”, these dependant claims now positively introduce structures already positively introduced in independent claim 1 and in doing so fail to further limit the claims. It is suggested that either these claims be made into new independent claims or the recitations be re-worded to refer back to the positive recitations in the independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-23-26, 29 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson (US Pat# 4,578,061). Lemelson discloses an elongate flexible body (70A), a delivery chamber/means for receiving (chamber in element 86) with a space and a port, and an actuator (90). The device also includes a control mechanism (93) and a plunger (90). The device is disclosed for use in arteries; therefore, its diameter is dimensioned small enough to traverse the vessels leading from the heart of a patient thereby making it small enough to enter

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the larger atrium and/or ventricles of the heart. See 8:23-52. The delivery chamber, as shown in figure 6 is substantially a cylindrical housing which is dimensioned to store a plurality of minispheres. Even though only one implant is shown within the delivery chamber, the length of the chamber clearly shows that the chamber is capable of housing multiple smaller implants in axial alignment. The implant may be "implanted into the tissue adjacent said head when the latter is disposed at a given location in a body duct, such as an artery, the intestine, throat or other body duct". See Summary 1:10+. A pointed distal end (94) is shown in figure 6 that has a hypodermic construction that would facilitate penetrating tissue. The distal end of the device in figure 6 has an arcuate shape. The device includes a steering mechanism (92,93).

Claims 27-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson in view of Leschinsky et al (US Pat# 5,873,499). Lemelson meets the claim limitations as described above but fails to include a ratchet assembly, a threaded plunger or a lever-action handle.

However, Leschinsky discloses a dispensing gun that includes a plunger (92) that may be threaded, notched (ratchet) or grooved (ratchet). The gun also includes a handle (62) that has a trigger (104) and a pawl (108).

At the time of the invention, it would have been obvious to substitute the threaded plunger of Leschinsky for the actuation assembly and plunger of Lemelson; and the handle, trigger and pawl of Leschinsky for the control mechanism of Lemelson. Both prior art references are analogous in the implant dispenser art and are also analogous with the claimed invention; therefore, a combination is proper. Additionally, it is well known in the art that

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trigger mechanisms with threaded or ratcheted dispenser mechanisms are more stable than hand actuated dispensing mechanism, such as the one by Lemelson. Therefore, the motivation for the combination would have been in order to enhance the control of the dispensing of the implant of Lemelson thereby increasing the safety of the device to the patient.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPNs 5,845,646; 5,322,510 and 4,861,336 teach similar inventions.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

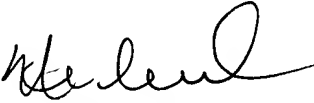
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 571-272-4970.

The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

Catherine S. Williams *den.*
June 13, 2005


NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700